

REMARKS

A. Introduction

Claims 1-18 were presented for examination.

Claims 1-18 were rejected.

Claims 1, 2, 11, 16 and 18 were amended.

Claims 3-10, 12-15, and 17 were cancelled.

B. Claims 1-18 Rejected Under 35 U.S.C. § 103

Examiner rejected Claims 1-5, 7-10, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2003/0211062 to Laden et al (Laden) in view of KR 149428 to Lee et al. (KR). Examiner also objected to Claims 3-10 and 13-15 contending that these claims improperly depend on the preceding claim. Examiner also rejected Claims 1-18 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (Page 4), by reciting the limitation “anhydrous,” which Examiner contends constitutes new matter not supported by the specification. Examiner further rejects Claims 6, 11-15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Laden in view of KR as applied to claims 1-10, 16 and 18 above, in further view of U.S. Patent No. 5,997,889 to Durr et al (Durr).

Applicants considered Examiner’s rejections and objections and amended certain claims and cancelled others accordingly. Specifically, Claims 1, 2, 11, 16, and 18 were amended. Further, Claims 3-10, 12-15, and 17 were cancelled. Additionally, notwithstanding the clear description and support in the specifications that no water is added to the present invention (and, thus, inherently anhydrous), to reduce issues remaining in this prosecution, Applicants eliminated the term “anhydrous” from the

remaining claims.

1. The cited references fail to teach or suggest all of the amended claim limitations.

The prior art references do not teach or suggest all of the amended claim limitations. None of the references cited by Examiner teach the limitation of “a mixture of at least 50% by weight of total composition of processed Dead Sea mineral particles suspended in a continuous all-natural carrier medium, consisting of an oil, and at least one essential oil,” as recited in amended Claim 1. Respectfully, Applicants submit that this amendment overcomes Examiner’s rejections.

Similarly, none of the cited references teach the limitation of “continuous all-natural carrier medium comprises at least one oil selected from the group consisting of palm oil, soybean oil, olive oil, jojoba oil, beeswax, jojoba wax, cashew husk oil ethoxylate, coconut oil and Vitamin E oil,” as recited in amended dependent Claim 2 which depends from amended Independent Claim 1. Claims 11 and 16 were also amended and depend from Independent Claim 1. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1296 (Fed. Cir. 1988); M.P.E.P. § 2143.03. Applicants submit that Claims 2, 11, and 16, as amended, overcome Examiner’s prior objections and rejections.

Claim 18 of the present invention specifically separates the processed Dead Sea minerals as an independent product from the processed Dead Sea minerals included in the chemical composition. Due to the inherent difficulties of working with Dead Sea minerals, as discussed in the present specification (*e.g.*, Page 7, line 21 through Page 8, line 6; also Page 8, line 16 through Page 9, line 3; Page 15, lines 11-14), prior to the

present invention, processing, or fractionalization, of these minerals to a size of less than 1.0 mm size granularity was not achievable.

The present invention includes a composition with processed Dead Sea minerals. However, equally as important is that the processed Dead Sea minerals, while included as part of the composition, are also a raw ingredient separate and apart from the composition. That is to say, that the ingredient “processed Dead Sea minerals” of the present invention can be used to manufacture other cosmetic compositions for application to the skin containing various concentrations of Dead Sea minerals. The processed Dead Sea minerals are not intended to be limited in any way as only being found in its particular granularity size only as a component of the cosmetic composition containing “at least 50% by weight of total composition of processed Dead Sea mineral particles,” as disclosed in the present invention.

In order to make this distinction more readily apparent, Applicants amended Claim 18 for further clarification. The added limitations are fully supported by the present specification which indicates that “[a]pplicant’s invention relates to ... processing native Dead Sea minerals into ... ultra fine mineral compound that can be used to manufacture all-natural Dead Sea mineral compositions particularly compositions for use in cosmetic preparations.” (Specification, Page 1, lines 5-8).

The present specification also indicates that “[t]he Dead Sea mineral compositions ... begins with the native Dead Sea minerals,” provides a description of the “granularity of the ultra fine minerals,” indicates that “[a] finer version of the minerals can be obtained,” and that “[t]he processing step for any version of the [Dead Sea] minerals ensures that 100% will have less than 10 mesh and 100% will have less than 1.0mm size

granularity.” (Page 12, line 3 through Page 14, line 6).

Further, the flow chart in Figure 1 of the present invention clearly illustrates that once the ultra-fine processing 102 of native Dead Sea salt 101 reaches barrels 107, the ultra-fine processed Dead Sea minerals are either transported for shipment 108 or used in mixing into composition 109. (See Fig. 1; see also Specification Page 15, lines 3-16).

Laden and KR speak of a cosmetic preparation which includes an “abrasive material” and a “large quantity of salt,” respectively. However, each reference speaks only of Dead Sea salts in a general term. While these “abrasive materials” and “large quantities of salt” may be found in a variety of sizes spanning the ranges cited within each respective reference, neither reference suggests that the Dead Sea minerals alone are of a uniformed granularity size as in the present invention.

In short, Laden and KR fail to teach the limitation of “[p]rocessed Dead Sea minerals to be used as an ingredient for use in manufacturing cosmetic compositions for application to the skin, 100% of said processed Dead Sea minerals consisting of an ultra-fine uniform specific granularity of less than 1.0 mm size granularity,” as recited in amended Claim 18. These limitations are nowhere to be found in either reference. Neither Laden alone nor in combination with KR teach or suggest all of the claim limitations of the present invention.

2. KR, as a foreign patent, must be strictly construed, and, as such does not make the present invention obvious, whether alone or in combination with other cited references.

The disclosure of a foreign patent is to be measured not by what may be made out of it, but what is clearly and definitely expressed in it. *Davies v. Coe*, 65 App. D.C. 345, 83 F.2d 602, 29 U.S.P.Q. 107 (App. D.C. 1936); *In re Ek*, 57 App. D.C. 203, 19 F.2d 677

(C.A.D.C. 1927); *Carson v. American Smelting & Refining Co.*, (C.C.A.) 4 F.2d 463 (9th Cir. 1925); *Switzer v. Marzall*, 96 F. Supp. 332, 333 (D.C. D.C. 1951); *General Tire & Rubber Co. v. Watson*, 184 F. Supp. 344, 349, 125 U.S.P.Q. 628 (D.C.D.C. 1960). Foreign prior art is to be strictly construed and restricted to what is clearly and definitely disclosed therein, not that which may be made out of it. *General Tire & Rubber Co. v. Watson*, 184 F. Supp. 344, 125 U.S.P.Q. 628 (D.C.D.C. 1960); *General Tire & Rubber Co. v. Firestone Tire & Rubber Co.*, 349 F. Supp. 345, 174 U.S.P.Q. 427 (N.D. Ohio 1972), *aff'd in part, rev'd in part and vacated in part on other grounds*, 489 F.2d 1105, 180 U.S.P.Q. 98 (6th Cir. 1973), *cert. denied*, 417 U.S. 932, 182 U.S.P.Q. 1 (1974). Nothing is to be treated as patented by a foreign patent except what is *actually claimed*. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 301 (1909); *Carter Products, Inc. v. Colgate-Palmolive Co.*, 130 F. Supp. 557, 104 U.S.P.Q. 314 (D. Md. 1955), *aff'd*, 230 F.2d 855, 108 U.S.P.Q. 383 (4th Cir. 1956), *cert. denied*, 352 U.S. 843, 111 U.S.P.Q. 467 (1956); *Permutit Co. v. Wadham*, 13 F.2d 454 (6th Cir. 1926).

In *General Tire & Rubber Co. v. Watson*, the Court, in reversing the refusal and holding that the applicant was entitled to a patent on all of the claims, stated:

There is no doubt that the [British] patent discloses in a general way the use of oil in the manufacture of synthetic rubber, but it cannot be said to point directly to the invention involved in this case and therefore, cannot be deemed to be an anticipation. It must be emphasized that the [British] patent does not refer to tough rubber as being one of the vital elements of the invention. It does not indicate any definite degree of toughness of the rubber to be used, nor is it limited to large quantities of oil. Moreover it does not show any advantages to be derived from the use of a large quantity of oil. *Id.* at 349.

KR does not teach or more importantly does not *actually claim* the limitation of

“a mixture of at least 50% by weight of total composition of processed Dead Sea mineral particles suspended in a continuous all-natural carrier medium, consisting of an oil, and at least one essential oil,” as recited in amended Independent Claim 1. Nor does KR indicate any definite degree of fractionalization that occurs with the Dead Sea minerals prior to their use in the composition.

Where the parts of the prior art device must be discarded in order to get to the patented invention, then such art does not make the invention obvious under the provisions of 35 U.S.C. § 103. *Uarco Inc. v. Moore Business Forms, Inc.*, 440 F.2d 580, 169 U.S.P.Q. 263 (7th Cir. 1971). In this case, respectfully, Examiner cannot simply discard KR’s claimed “oil-in-polyol” component in order to maintain an obviousness rejection. Respectfully, Examiner also cannot dismiss that KR claims not only Dead Sea salt (albeit unprocessed), but other salts as well as a component of a composition. Further, KR does not claim the Dead Sea salts alone, but only as they are found within a composition. There is also no indication in the claims or otherwise that the Dead Sea salt in KR, as a separate raw ingredient all by itself, is processed, resulting in Dead Sea salt minerals of an ultra fine uniform specific granularity size of less than 1.0 mm.

Further still, there is no indication that the composition claimed in KR is made up of Dead Sea salt minerals of an ultra-fine uniform specific granularity size rather than of Dead Sea salts of mixed various particle sizes but all within the claimed range of KR, as Examiner contends. (Pages 5-6). As a foreign patent, KR is restricted to what is clearly and definitely disclosed. Therefore, KR fails entirely to provide adequate disclosures regarding either a composition with processed Dead Sea minerals or processed Dead Sea minerals alone. KR, whether alone or in combination with the other cited references does

not render the present invention obvious.

3. No suggestion to combine references can be found in the cited references.

To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371, 56 U.S.P.Q. 2d 1065 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 974 (2001); *Ryko Mfg. Co. v. Nu-Star Inc.*, 21 U.S.P.Q.2d 1053, 1057 (Fed. Cir. 1991); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); M.P.E.P. § 2142. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d at 1075. The mere fact that cited references can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. *In re Imperato*, 486 F.2d 585, 587 (C.C.P.A. 1973); *In re Bergel*, 48 C.C.P.A. 1102, 292 F.2d 955 (1961). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *Ecolochem Inc.*, 227 F.3d at 1371-72. As the Court in *In re Adams* stated:

The real and only issue under 35 U.S.C. § 103 is whether the invention as a whole would have been obvious to those skilled in the art at the time Adams made it in view of the state of the art as we are able to glean it from the references cited. Of course all of the references may be used to show what the art knew, and in that sense “combined” but *the fact remains that neither reference contains the slightest suggestion to use what it discloses in combination with it what is disclosed in the other.* 53 C.C.P.A.

996, 1001-1002, 148 U.S.P.Q. 742 (C.C.P.A. 1966) (emphasis added).

As the Court in *In re Rinehart* stated:

Absence of any suggestion in either [of the two cited references] that features of the process of one should be combined with features of the other to achieve the commercial scale production of which neither is capable requires a holding that the rejection herein was improper. 513 F.2d 1048, 1054 (C.C.P.A. 1976).

The key word in the above cited cases is “suggested.” The common meaning of the term “suggest” is to recommend, to propose as desirable, to offer for consideration, and to mention as a possibility. The term “suggest” has a positive meaning.

The three references, KR, Laden, and Durr, which are relied upon by Examiner are, in no way, combinable to produce the present invention. Further, KR actually teaches away from combining the references as suggested by Examiner as KR recognized that “[o]il-in-water or Water-in-oil emulsion that utilizes water generally has a drawback that salt cannot be used in large quantity because the dissociation of salt significantly reduces the solubility of a surfactant.” (Page 3). Finally, Durr contains water.

It is submitted that the present invention is not suggested, recommended, proposed or offered for consideration to one skilled in the art. The Declaration of Joseph P. Ettari, attached hereto and incorporated by reference herein, provides additional supporting evidence that the present invention is not obvious to one skilled in the art. The combination of these references constitutes improper hindsight analysis as there simply is no positive direction in the prior art of the claimed invention. Examiner is respectfully invited to indicate where, in each reference, a positive suggestion exists to combine with the other cited references.

It is respectfully submitted that Applicants’ claims, as amended, overcome all of

Examiner's objections and rejections thereto. As there is no positive and direct suggestion in any of the references to combine together to make this specific combination as described in the present invention and claimed in the amended claims, Examiner is respectfully requested to withdraw her objections and rejections.

CONCLUSION

In view of the above, Applicants submit that Claims 1, 2, 11, 16, and 18 are in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the rejections and objections. Allowance of Claims 1, 2, 11, 16, and 18 at an early date is solicited. If Examiner still finds impediments to allow Claims 1, 2, 11, 16, and 18 and, in the opinion of the Examiner, a telephone conference between the undersigned and Examiner would help remove such impediments, the undersigned respectfully requests such a telephone conference.

Respectfully submitted,

GUNN & LEE, P.C.
700 North St. Mary's Street, Suite 1500
San Antonio, TX 78205-3596
(210) 886-9500
(210) 886-9883 (Fax)

By: 

Miguel Villarreal, Jr.
Regis. No. 55,700



CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service in an envelope addressed to the "COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450" as follows:

<p style="text-align: center;"><u>37 CFR 1.8(a)</u></p> <p><input type="checkbox"/> With sufficient postage as First Class Mail.</p> <p>Date: _____, 2006</p>	<p style="text-align: center;"><u>37 CFR 1.10</u></p> <p><input checked="" type="checkbox"/> As "Express Mail Post Office to Addressee," Mailing Label No. EV <u>680055418</u> US.</p> <p>Date: June <u>5</u>, 2006</p>
---	---

Documents Enclosed:

1. Response to Office Action of March 7, 2006 with Certificate of Mailing;
2. Declaration Under 37 C.F.R. § 1.132; and
3. Acknowledgment Card.


Lezah D. Medrano

G:\TDL\EarthSalts\IP-5435D1(RCE)\OA response March.doc